

## **REMARKS**

Claims 1-40 are pending in the application. Claims 1, 6, 11, 17, 38, and 40 are the only independent claims.

### ***Restriction Requirement***

Claims 1-40 stand subject to a Restriction Requirement according to which the Examiner has divided the claims into two groups, namely, Group I including claims 1-16, 38 and 39 directed to a laparoscopic medical instrument and Group II containing claims 17-37 and 40 drawn to a cannula and instrument holder.

In response to the Restriction Requirement, applicant elected the claims of Group II, i.e., claims 1-17 and 40, for continued prosecution in the application. Claims 1-16, 38 and 39 have been withdrawn from consideration by the Examiner.

### ***Claims Rejections - 35 U.S.C. §§ 102 and 103***

Claims 17-25, 28-31, 33-35, and 40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,551,270 to Bimbo et al. ("Bimbo").

Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bimbo et al. in view of U.S. Patent No. 5,803,921 to Bonadio.

Claims 36 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bimbo et al. in view of U.S. Patent No. 6,551,270 to Yoon.

The Examiner has indicated that claim 32 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Applicant respectfully traverses the Examiner's use of the Bimbo reference in rejecting claims 17-37 and 40. Applicant traverses the rejections under 35 U.S.C. § 102(e) and § 103(a) on the grounds that ***applicant made his invention prior to the effective filing***

*date of Bimbo*. More specifically, applicant *constructively reduced his invention to practice* on September 15, 1999 with the filing of U.S. Patent Application No. 09/397,630, now U.S. Patent No. 6,454,783 (“the ‘783 patent”). See *Alexander Milburn Company v. Davis-Bournonville Company*, 270 U.S. 390 (1926).

For reasons set forth in detail hereinafter with respect to the subject matter of the individual pending claims, the ‘783 patent represents a constructive reduction to practice of applicant’s invention. The filing date of the ‘783 patent, September 15, 1999, substantially precedes August 30, 2000, the effective filing date of the Bimbo reference. Accordingly, Bimbo is not prior art to the instant application under 35 U.S.C. § 102(e).

Applicant’s invention is basically disclosed in the ‘783 patent. The ‘783 patent is not prior art to the instant claims under 35 U.S.C. § 102(b) since the present application was filed prior to the one year anniversary of the ‘783 patent. The ‘783 patent is not prior art to the instant claims under 35 U.S.C. § 102(a) since applicant is the inventor in the ‘783 patent.

Applicant directs the Examiner’s attention chiefly to Figure 8 of the ‘783 patent and the associated description.

**Claim 17** Per claim 17, Figure 8 shows a cannula and instrument holder for laparoscopic surgical operations, the holder comprising a plate member (31 and/or 32) having a surrounding edge, and a wall (34) surrounding the plate member. The wall is connected to the plate member all along the edge and has a longitudinal axis. The plate member extends substantially transversely to the axis. The plate member is provided with a plurality of apertures (traversed by cannulas 7) for receiving respective elongate laparoscopic surgical members.

**Claim 18** Per claim 18, the plate member (31, 32) and the wall (34) of shown in Figure 8 of the ‘783 patent each have a height dimension extending parallel to the axis, the

height dimension of the wall (34) being at least as great as the height dimension of the plate member.

**Claim 19** Per claim 19, the height dimension of the wall is substantially greater than the height dimension of the plate member.

**Claim 20** Per claim 20, the wall (34) of the cannula and instrument holder (30) of Figure 8 has at least one end portion extending as a flange to the plate member. Per claim 21, the wall has two end portions extending as endless flanges to the plate

**Claim 22** Claim 22 recites that the plate member is located at one end of the wall. This is feature of applicant's invention is not explicit or implicit in the disclosure of the '783 patent. However, applicant respectfully traverses the Examiner's interpretation of the Bimbo disclosure in maintaining that the *center* location along the sidewall is at the "inner" *end* of the wall. Applicant's plate member is eccentrically placed, a feature not found in Bimbo.

**Claim 24** Per claim 24, the plate member (31, 32) and the wall (34) of the cannula and instrument holder of Figure 8 of the '783 patent form a cup shape.

**Claim 25** Per claim 25, the wall (34) of Figure 8 of the '783 patent has a first inner diameter at the plate member (31, 32) and a second inner diameter at an end opposite the plate member, the second inner diameter being larger than the first inner diameter. The flanges of the wall (34) on the opposite sides of the plate (31, 32) flare outwardly, so naturally the diameters are so related.

**Claims 26 and 27** With respect to claims 26 and 27, applicant's '783 patent recites that the cannula and instrument holder unit (30) is inflatable (column 7, line 32). While it may be unclear from the '783 patent whether the plate (31, 32) is inflatable, applicant asserts that the plate or opening (70) of Figures 8-12 of the Bimbo patent is not inflatable. The opening (70) is a solid element with apertures (72, 74). Moreover, Bonadio discloses a

surgical port device where inflatable chambers are placed about a sleeve. That reference does not suggest that a flexible plate extending across the sleeve, as the opening element (70) of Bimbo, be inflatable. Bonadio teaches and suggests placing a *separate* inflatable chamber *about* a cannula and instrument holder as in Bimbo.

**Claims 28 and 33** Per claims 28 and 33, the fact that the cannula and instrument holder (30) of the '783 patent is inflatable implies that the plate member (31, 32) and the wall of Figure 8 of the '783 patent are flexible.

**Claim 29** Per claim 29, the cannula and instrument holder (30) of the '783 patent consists of the plate member and the wall.

**Claims 30 and 31** With reference to claim 30, applicant respectfully traverses the Examiner's interpretation of the Bimbo reference. One of ordinary skill in the art would not interpret the features marked 72 and 74 in Bimbo's Figure 11 as being extensions pursuant to applicant's present disclosure, but would instead view Figure 11 as schematic. Figure 12, a more complete and accurate representation, shows that there are no extensions or projecting port elements as set forth in applicant's claim 30.

**Claim 32** The Examiner rightfully indicated that claim 32 contains allowable subject matter.

**Claim 34** Per claim 34, the wall (34) of Figure 8 of applicant's '783 patent is at least partially curved in a direction parallel to the axis.

**Claim 35** Applicant respectfully maintains that claim 35 is patentable over the prior art. The Bimbo references does not disclose a gas channel in at least one of the at least one of the plate member and the wall for the introduction of an insufflation gas into a patient.

**Claims 36 and 37** Applicant respectfully traverses the rejection of claim 36. The anchoring system of Yoon is provided on the bottom surface of a plate disposed on a skin

surface. The cannula and instrument holder of Bimbo has no plate that is in such contact with an outer surface of a patient's skin that the anchors of Yoon could be used. One of ordinary skill in the art would have no idea as to how to provide anchors on the Bimbo cannula and instrument holder pursuant to the teachings of Yoon.

**Claim 40** The Examiner does not point to anything specific in Bimbo that anticipates the subject matter of claim 40. Applicant respectfully traverses the rejection of claim 40. Bimbo does not appear to disclose or suggest the funnel shaped port elements of claim 40. Bimbo discloses a plurality of cylindrical port elements in Figures 1-7 and Figures 13-16.

In view of applicant's prior patent, applicant maintains that a declaration or affidavit under 37 C.F.R. § 1.131 is unnecessary in this case.

**Observations with Respect to Examiner's Response to Applicant's Arguments**

In the Office Action of February 13, 2006, the Examiner contends that applicant must have claimed priority from the '783 patent in order to exclude Bimbo as prior art. The Examiner additionally contends that applicant must establish a chain of continuity between the present application and the '783 patent and that otherwise applicant is entitled only to the filing date of the present application.

The Examiner's contentions clearly miss the point. Applicant is not claiming a priority date. Instead, applicant is asserting a constructive reduction to practice that predates the effective filing date of the Bimbo reference. The '783 patent demonstrates that applicant had completed his invention before the invention date (filing date) of the Bimbo patent.

Applicant is prepared to file a Notice of Appeal and a Pre-Appeal Brief Request for Review inasmuch as the Examiner's position represents a misunderstanding of the law.

***Conclusion***

For the foregoing reasons, independent claim 1, as well as the claims dependent therefrom, is deemed to be in condition for allowance. An early Notice to that effect is earnestly solicited.

Should the Examiner believe that direct contact with applicant's attorney would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,

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